



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,502	06/22/2005	Motoki Tsunokawa	261889US6PCT	7858

22850 7590 12/28/2009
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

INGVOLDSTAD, BENNETT

ART UNIT	PAPER NUMBER
----------	--------------

2427

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

12/28/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/518,502	Applicant(s) TSUNOKAWA ET AL.	
	Examiner Bennett Ingvaldstad	Art Unit 2427	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 2 September 2009 have been fully considered.

Applicant traverses the 112 rejections, citing pages 35 and 36 of the specification as providing support for the claims. Remarks at 4. Those pages refer to a recording/reproducing apparatus 3, a television receiver 4, and a server 2. See also Fig. 13.

The claims require that the apparatus/computer communicates with a recording and playback apparatus. Therefore, the claims are not directed to the recording/reproducing apparatus 3, since the specification does not describe a recording and playback/reproducing apparatus communicating with other recording and playback/reproducing apparatuses. The claims are further not directed to a server 2, because the apparatus comprises a user device. A server is not a user device. See Remarks at 5. The claims are not directed to a television receiver 4, because a television receiver does not receive a file containing information about a characteristic word as required by the claim. See Fig. 13, steps S31 and S42. Therefore, it is unclear what device is being claimed. The three devices described in the cited portion of the specification are clearly not the same as an apparatus comprising four devices that communicates with a fifth recording and reproducing device. The claims do not have support in the specification, and the 112 rejections are maintained.

Arguments against the art rejections are moot in view of the new interpretation of the Knudson reference to meet the amended claims.

Claim Rejections - 35 USC § 112

Claims 13-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claim 13 describes an apparatus comprising a first device, an input device, a device, and a second device. The second device receives "...information about a television program corresponding to said selected characteristic word transmitted from said recording and playback apparatus...." However, the examiner finds no support in the specification for a second device that receives a characteristic word transmitted from a recording and playback apparatus. Referring specifically to Figure 13, step S31, the characteristic word is transmitted **from** a server 2 **to** a recording and playback apparatus 3. The specification provides no support for receiving the word **from** a recording and playback apparatus at a second device. Therefore, the claim contains new matter.

Claim 14 further describes a first device for receiving "a file containing information about said characteristic word from said recording and playback apparatus". Referring to Figure 13, step S31, the characteristic word file is transmitted **from** a server

Art Unit: 2427

2 **to** a recording and playback apparatus 3. The specification provides no support for receiving the file **from** a recording and playback apparatus. Therefore, the claim contains new matter.

The same argument as above applies further to claim 15, which contains identical language requiring the reception of a characteristic word from a recording and playback apparatus.

Claim 16 describes “controlling reception of a file containing information about a characteristic word representing a characteristic of a television program”. Again referring to Figure 13, step S31, the characteristic word file is transmitted **from** a server 2 **to** a recording and playback apparatus 3. Therefore, since claim 16 describes receiving a characteristic word file, the specification only provides support for the computer program of claim 16 being executed by the recording and playback apparatus 3 of Figure 13.

However, the claim goes on to describe “controlling transmission of information ... to a recording and playback apparatus”. The specification provides no support for transmitting information from a recording and playback apparatus to a recording and playback apparatus. Therefore, the claim contains new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2427

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13–16 are rejected under 35 U.S.C. 102(e) as being anticipated by Knudson (US 2006/0095937).

Knudson teaches:

Claim 13: An information processing apparatus comprising:

a first device (user equipment) configured to receive a file containing information about a characteristic word representing a characteristic of a television program (user equipment receives from the headend a list of categories by which television programs are classified, para. 0053);

an input device (remote control) configured to allow a user to select an intended characteristic word from characteristic words contained in said file (remote control 42 for selecting displayed categories, Fig. 1; para. 0056);

a user device (remote control transmitter) configured to transmit information about a characteristic word selected by said user to a recording and playback apparatus (remote control selects a displayed category via communication with user equipment, para. 0056; user equipment may be a recording and reproducing apparatus, para. 0040); and

a second device (television) configured to receive television program information about a television program corresponding to said selected characteristic word

Art Unit: 2427

transmitted from said recording and playback apparatus as a result of transmitting information about said selected characteristic word (a television 40 displays the search results for the user, Fig. 1; para. 0063).

Claim 14: Knudson further teaches that the characteristic word file is received from the recording and playback apparatus (from user equipment, para. 0053; user equipment may be a recording and playback device, para. 0040).

Knudson teaches:

Claim 15: An information processing method comprising:

controlling reception of a file containing information about a characteristic word representing a characteristic of a television program (user equipment receives from the headend a list of categories by which television program are classified, para. 0053);

allowing a user to select an intended characteristic word from characteristic words contained in said file (selecting a category from the list, para. 0056);

controlling transmission of information about a characteristic word selected by said user from a user device to a user recording and playback apparatus (remote control transmits the selected work to the user equipment, para. 0056; user equipment may be a recording and playback apparatus, para. 0040); and

controlling reception of television program information about a television program corresponding to said selected characteristic word transmitted from said recording and playback apparatus as a result of transmitting information about said selected

Art Unit: 2427

characteristic word (user equipment receives search results after transmitting a search query comprising a characteristic word to a server with database 24, para. 0062).

Knudson teaches:

Claim 16: A computer readable medium encoded with a computer program to allow a computer to perform:

controlling reception of a file containing information about a characteristic word representing a characteristic of a television program (user equipment receives from the headend a list of categories by which television program are classified, para. 0053);

allowing a user to select an intended characteristic word from characteristic words contained in said file (selecting a category from the list, para. 0056);

controlling transmission of information about a characteristic word selected by said user from a user device to a user recording and playback apparatus (remote control transmits the selected work to the user equipment, para. 0056; user equipment may be a recording and playback apparatus, para. 0040); and

controlling reception of television program information about a television program corresponding to said selected characteristic word transmitted from said recording and playback apparatus as a result of transmitting information about said selected characteristic word (receiving the search results from the server, para. 0063).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bennett Ingvaldstad whose telephone number is (571) 270-3431. The examiner can normally be reached on M–F 9–5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2427

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bennett Ingvaldstad/
Examiner, Art Unit 2427

/Jason P Salce/

Primary Examiner, Art Unit 2421